



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,882	02/21/2002	Ken Kutaragi	450126-04025	2953

7590 02/25/2005

William S. Frommer
Frommer, Lawrence & Haug LLP
845 Fifth Avenue
New York, NY 10151

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,882

Applicant(s)

KUTARAGI ET AL

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2002.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-52 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/01;6/02;7-9/02.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an applications filed on 17 January 2000, 30 January 2000, and 09 June 2000. It is noted, however, that applicant has not filed a certified copy of these applications (JAPAN 2000-08253, JAPAN 2000-22553, and JAPAN 2000-173754) as required by 35 U.S.C. 119(b).

Specification

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 46-52 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Entities representing human beings are claimed as structural elements. For examination purposes only, the following language is assumed: "a licensor" to

mean "licensor computer;" "a distributor" to mean "a distributor computer;" and "a licensee" to mean "a licensee computer." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1 and 9 lack structural specificity. For examination purposes only, "order accepting process" is assumed to mean "order accepting process system" and "consideration determining process" is assumed to mean "consideration determining process system."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-17, 20-24, 34-37, 40-43, and 46 are rejected under 35 USC 102(b) as being anticipated by Freeny, Jr. (US 4,528,643 hereinafter referred to as "Freeny").**

Freeny teaches all the limitations of Claims 1-17, 20-24, 34-37, 40-43, and 46. For example, Freeny discloses a computer-implemented method for managing the sale of an article from a product distributor (see at least abstract; Fig. 1(12, 14, 18, 20); col. 1, line 5 through col. 4, line 19). Freeny further discloses:

- receiving payment corresponding to a selling price for the article, the payment being received by a distributor of the article from a buyer of the article: (see at least col. 13, lines 25-48).
- determining a royalty due to a licensor of the article, based on the selling price of the article; transmitting, from the licensee to the licensor, payment corresponding to the royalty, upon a sale the article to the customer:

owner of recordings pay recording artists (please note: content creators) and songwriters (please note: content creators) in connection with sale (please note examiner's interpretation: determining and paying a royalty to licensors who create the content) (see at least col. 15, lines 12-23); distributor (please note: information control computer) transmits digital content to retailer (please note: a manufacturer); retailer pays for recording sold (please note examiner's interpretation: paying amount due to format holder who pays licensor) (see at least Fig. 1(12, 14); col. 4, line

35 through col. 13, line 24; col. 14, lines 56-68; col. 15, lines 12-23);

remote manufacturing system (e.g. retailer) pays the information control machine (e.g. distributor, publisher) which credits royalty payments (see at least col. 26, lines 20-25).

- transmitting, from the distributor to a manufacturer of the article, portions of the selling price payment corresponding to a royalty and a licensee margin portion of the selling price, wherein the manufacturer is a licensee of the article: The reference inherently discloses the structure and method that permits the function to be performed. As noted above, the remote manufacturing system (e.g. manufacturer) pays the information control machine (e.g. distributor, publisher) that credits royalty payments to content artists. To make the proper payments, the distributor must communicate to the manufacturer the portions of the selling price due the distributor.
- Digital content: video games, motion pictures, software, books, etc embodied on recordable media (see at least col. 1, lines 5-26; col. 4, lines 35-59).
- Format holder: information control computer as noted above.
- Program product executed on server; recordable medium: (see at least Fig. 1 (26); col. 6, lines 38-52).
- Retail selling price, cost of inventory; economic considerations: retailers inventory blank recordable media (please note examiner's interpretation:

there is a predetermined cost associated with blank media owned by a retailer) (see at least col. 14, lines 54-68); retailer loads digital content to blank media and pays for the digital content used (please note examiner's interpretation: subtotal cost at least includes predetermined cost of blank media, predetermined cost of digital content payable to distributor which includes a predetermined royalty to content creators (see at least col. 15, lines 12-23), and predetermined cost of manufacturing process); retailer sells it to a consumer at a predetermined retail price (please note examiner's interpretation: retailer adds margin to at least cover marketing, overhead, and profit) (see at least col. 2, line 62 through col. 3, line 25).

- Product identification codes: identifying content by codes (see at least col.5, lines 1-31).
- Customer terminal: (see at least Fig. 4 (34); col. 26, line 26 through col. 28, line 15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 6. Claims 18 and 19 are rejected under 35 USC 103(a) as being unpatentable over Freeny (US 4,528,643), in view of Official Notice (regarding well within the skill, hereinafter referred to as "ON1").**

Freeny teaches all the above as noted under the 102(b) rejection and teaches a) mailing purchased material objects to consumers, and b) consumers making purchases at a retail location. The Examiner takes the position this it is well within the skill to ascertain that delivering material objects requires at least a delivery address, means of delivery, and means to record delivery instructions (e.g. requested delivery date) as requested by the consumer. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Freeny, since it is well within the skill to ascertain delivering a material object purchased by a consumer requires a delivery address, means of delivery, and means to record delivery instructions.

- 7. Claims 25-33 are rejected under 35 USC 103(a) as being unpatentable over Freeny (US 4,528,643) in view of Rembert (US 5,101,352).**

Freeny teaches a computer-implemented method for managing the sale of an article from a product distributor (see at least abstract; Fig. 1(12, 14, 18, 20); col. 1, line 5 through col. 4, line 19). Freeny further teaches:

- receiving payment corresponding to a selling price for the article, the payment being received by a distributor of the article from a buyer of the article: (see at least col. 13, lines 25-48).

- determining a royalty due to a licensor of the article, based on the selling price of the article; transmitting, from the licensee to the licensor, payment corresponding to the royalty, upon a sale the article to the customer:

owner of recordings pay recording artists (please note: content creators) and songwriters (please note: content creators) in connection with sale (please note examiner's interpretation: determining and paying a royalty to licensors who create the content) (see at least col. 15, lines 12-23); distributor (please note: information control computer) transmits digital content to retailer (please note: a manufacturer); retailer pays for recording sold (please note examiner's interpretation: paying amount due to format holder who pays licensor) (see at least Fig. 1(12, 14); col. 4, line 35 through col. 13, line 24; col. 14, lines 56-68; col. 15, lines 12-23); remote manufacturing system (e.g. retailer) pays the information control machine (e.g. distributor, publisher) which credits royalty payments (see at least col. 26, lines 20-25).

- transmitting, from the distributor to a manufacturer of the article, portions of the selling price payment corresponding to a royalty and a licensee margin portion of the selling price, wherein the manufacturer is a licensee of the article: The reference inherently discloses the structure and method that permits the function to be performed. As noted above, the remote manufacturing system (e.g. manufacturer) pays the information control machine (e.g. distributor, publisher) that credits royalty payments to

content artists. To make the proper payments, the distributor must communicate to the manufacturer the portions of the selling price due the distributor.

- Digital content: video games, motion pictures, software, books, etc embodied on recordable media (see at least col. 1, lines 5-26; col. 4, lines 35-59).
- Format holder: information control computer as noted above.
- Program product executed on server; recordable medium: (see at least Fig. 1 (26); col. 6, lines 38-52).
- Retail selling price, cost of inventory; economic considerations: retailers inventory blank recordable media (please note examiner's interpretation: there is a predetermined cost associated with blank media owned by a retailer) (see at least col. 14, lines 54-68); retailer loads digital content to blank media and pays for the digital content used (please note examiner's interpretation: subtotal cost at least includes predetermined cost of blank media, predetermined cost of digital content payable to distributor which includes a predetermined royalty to content creators (see at least col. 15, lines 12-23), and predetermined cost of manufacturing process); retailer sells it to a consumer at a predetermined retail price (please note examiner's interpretation: retailer adds margin to at least cover marketing, overhead, and profit) (see at least col. 2, line 62 through col. 3, line 25).

- Product identification codes: identifying content by codes (see at least col.5, lines 1-31).
- Customer terminal: (see at least Fig. 4 (34); col. 26, line 26 through col. 28, line 15).

Freeny teaches all the above as noted under the 103(a) rejection and teaches a) blank media, blank media having a cost without value added cost, b) manufacturing a retail material object containing component costs and value add costs, and c) manufacturing a material object customized for the individual consumer, but does not disclose specifics on materials planning and production. Rembert teaches material requirements planning (MRP) for distributors, manufacturers, and job shops. Rembert teaches MRP as a technique for determining the net time phased requirement of dependent items parts or sub-assemblies from known or assumed independent demand (e.g. sales orders or sales forecasts) (see at least abstract; Fig. 1(18); Fig. 2; Fig. 3; Fig. 9; col. 1, lines 5-24). Rembert teaches providing a system and method that accommodates a wide variety of product options (many-to-one relationship in order to customize the product) (see at least col. 1, line 24 through col. 2, line 68). Rembert further teaches:

- a receiver unit for receiving an article manufacturing cost and the number of articles manufactured which are inputted; storage: (see at least col. 6, lines 30-51).

- an order-accepting unit for accepting an order by receiving at least identification information of an ordered article and the number of articles: (see at least col. 5, lines 44-64).
- a stock-article calculation unit for calculating the number of articles in stock at a specific time from the number of the manufactured articles stored in said storage unit and the number of ordered articles received by said order-accepting unit: (see at least col. 5, line 66 through col. 6, line 17).
- a stock balance calculation unit for calculating a balance of stock at the specific time based on the calculated number of articles in stock and the manufacturing cost stored in said storage unit, wherein the balance of stock calculated by said stock balance calculation unit does not include at least a consideration corresponding to the added value: (see at least col. 5, line 66 through col. 6, line 17).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Freeny to implement materials requirements planning for distributors, manufacturers, and job shops as taught by Rembert, in order to accommodate production planning for customized products.

8. **Claims 38, 44, and 47-52 are rejected under 35 USC 103(a) as being unpatentable over Freeny (US 4,528,643), in view of Official Notice (old and well known, hereinafter referred to as "ON2").**

Freeny teaches all the above as noted under the 102(b) rejection and teaches a) costs associated with selling a manufactured item to a consumer by a retailer at a retail price, b) cost components associated with acquiring digital content by a retailer from a distributor, and c) royalties for content creators as a cost component of the distributor's cost. Freeny, however, does not specifically disclose margins. The Examiner takes the position that it is old and well known in the art to describe cost relationships of a manufactured item or derive the cost of a manufactured item in terms of component costs, margins, and royalties. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Freeny to disclose royalty-cost relationships as taught by ON2, in order to derive retail pricing, and thereby attract retailers to the service.

- 9. Claims 39 and 45 are rejected under 35 USC 103(a) as being unpatentable over Freeny (US 4,528,643) and ON2 (regarding old and well known), as applied to Claims 38 and 44, further in view of Rembert (US 5,101,352).**

Freeny and ON2 teach all the above as noted under the 103(a) rejection and teach a) blank media, blank media having a cost without value added cost, b) manufacturing a retail material object containing component costs and value add costs, and c) manufacturing a material object customized for the individual consumer, but do not disclose specifics on materials planning and production.

Rembert teaches material requirements planning (MRP) for distributors, manufacturers, and job shops. Rembert teaches MRP as a technique for determining the net time phased requirement of dependent items parts or sub-assemblies from known or assumed independent demand (e.g. sales orders or sales forecasts) (see at least abstract; Fig. 1(18); Fig. 2; Fig. 3; Fig. 9; col. 1, lines 5-24). Rembert teaches providing a system and method that accommodates a wide variety of product options (many-to-one relationship in order to customize the product) (see at least col. 1, line 24 through col. 2, line 68). Rembert further teaches:

- a receiver unit for receiving an article manufacturing cost and the number of articles manufactured which are inputted; storage: (see at least col. 6, lines 30-51).
- an order-accepting unit for accepting an order by receiving at least identification information of an ordered article and the number of articles: (see at least col. 5, lines 44-64).
- a stock-article calculation unit for calculating the number of articles in stock at a specific time from the number of the manufactured articles stored in said storage unit and the number of ordered articles received by said order-accepting unit: (see at least col. 5, line 66 through col. 6, line 17).
- a stock balance calculation unit for calculating a balance of stock at the specific time based on the calculated number of articles in stock and the

manufacturing cost stored in said storage unit, wherein the balance of stock calculated by said stock balance calculation unit does not include at least a consideration corresponding to the added value: (see at least col. 5, line 66 through col. 6, line 17).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Freeny and ON2 to implement materials requirements planning for distributors, manufacturers, and job shops as taught by Rembert, in order to accommodate production planning for customized products.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 5,532,920 (Hartrick et al.) 02 July 1996, cited in IDS filed 13 August 20022; teaches royalty payment scheme included with digital content.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

Art Unit: 3625

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. M. Pond', with a large, stylized loop at the end.

Robert M. Pond
Primary Examiner
16 February 2005